UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/707,956	01/28/2004	Gilbert J. Yablon	YABLP005US	1955

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LAW OFFICE OF JAY R. YABLON
910 NORTHUMBERLAND DRIVE
SCHENECTADY, NY 12309-2814

EXAMINER
ADDY, THJUAN KNOWLIN

ART UNIT	PAPER NUMBER
2614	

MAIL DATE	DELIVERY MODE
04/08/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Advisory Action **_Before the Filing of an Appeal Brief_**	*10/707,956*	YABLON, GILBERT J.
	Examiner	**Art Unit**	
	THJUAN K ADDY	2614	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED <u>31 March 2009</u> FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

    a) ☒ The period for reply expires <u>3</u> months from the mailing date of the final rejection.

    b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

      Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

<u>NOTICE OF APPEAL</u>

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

<u>AMENDMENTS</u>

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will <u>not</u> be entered because

    (a)☐ They raise new issues that would require further consideration and/or search (see NOTE below);

    (b)☐ They raise the issue of new matter (see NOTE below);

    (c)☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

    (d)☐ They present additional claims without canceling a corresponding number of finally rejected claims.

      NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☐ Applicant's reply has overcome the following rejection(s): _____.

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

    The status of the claim(s) is (or will be) as follows:

    Claim(s) allowed: _____.

    Claim(s) objected to: _____.

    Claim(s) rejected: _____.

    Claim(s) withdrawn from consideration: _____.

<u>AFFIDAVIT OR OTHER EVIDENCE</u>

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will <u>not</u> be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will <u>not</u> be entered because the affidavit or other evidence failed to overcome <u>all</u> rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

<u>REQUEST FOR RECONSIDERATION/OTHER</u>

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: <u>See Continuation Sheet.</u>

12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____

13. ☐ Other: _____.

   /Ahmad F. Matar/
   Supervisory Patent Examiner, Art Unit 2614

Continuation of 11. does NOT place the application in condition for allowance because:

Applicant's arguments filed on 3/31/2009 have been fully considered but they are not persuasive.

On page 4 of Applicant's remarks, Applicant argues the following:
- "In applicant's view, this claim recitation is an inherent function of what is disclosed in US 60/047,747, that it is proper to have amended the claims to recite this function without introducing proibited new matter, and that US 60/047,747 consequently does provide adequate support or enablement for the limitation "without analyzing said seven-digit telephone number in relation to telephone numbers previously dialed by the user," in the manner provided by the first paragraph of 35 U.S.C. 112. Specifically: US 60/047,747, in point 2) on page 3/49 of the PDF document provided to the examiner, states: "If dialing starts with at 0 or a 1, all of the dialed digits will be passed directly through the system, since this is an indicator that the suffix system will not be used. If dialing starts with other than a 0 or 1: All digits are stored in the phone's special 'overlay system memory', and none are passed through until either: 1) 7 digits have been entered + a timing interval has elasped, in which case, the area code ... is output by the phone, follwed by the first 7 digits that were stored in the 'overlay system memory'. 2) 8 digits have been entered, in which case... [t]he proper area code is output, followed by the first 7 digits that were stored in the 'overlay system memory'."

The examiner respectfully disagrees with Applicant's arguments for the following reasons:
As per MPEP 2163.07(a), inherency, however, may not be established by probabilities or possibilities. The following is analysis of claim 1 with respect to 60/047,747 PDF document (herein after "PDF"):
   -Claim 1 has limitation of "the user **specifying** a seven-digit telephone number". Which seems more like setup or programming. In point 2) on page 3/49 of the PDF document discloses **dialing**, **dial digits**.
   -Claim 1 does not recite any condition such as dialing 0 or 1. While PDF discloses conditional dialing of 0 and 1.
   -Claim 1 recites using of area code + 7 digits, while there is no mention of an area code in point 2) of page 3/49 PDF document.
   -PDF page 3/49 refers to a "suffix" sytem, while suffix is not relevant to or recited in claim 1.

 Applicant is reading limitations into the claim and also reading limitations into the PDF. In view of above comparision and arguments, the subject matter of Applicant's independent claims is not fully disclosed in the priority application US 60/047,747.

While some ot Applicant's arguments may be generally correct such as dialing an area code followed by 7 digits may be passed through without analyzing previously dialed number, the issue here is the exact nexus or lack thereof between the language in the claims and the language in the PDF document.